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10/536,787	05/27/2005	Jong-Do Park	SNJ-0003	4287

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EXAMINER
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UBER, NATHAN C

ART UNIT	PAPER NUMBER
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3622

NOTIFICATION DATE	DELIVERY MODE
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10/23/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,787	<b>Applicant(s)</b> PARK ET AL.	
	<b>Examiner</b> NATHAN C. UBER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 16 July 2008.
2. Claim 10 has been amended.
3. Claims 24-26 have been added.
4. Claims 13-22 have been canceled.
5. Claims 1-12 and 23-26 are currently pending and have been examined.

### **Specification**

6. The abstract of the disclosure was objected to because it was not submitted on a separate sheet. Appropriate corrections were made. The objection is withdrawn.

### **Claim Objections**

7. Claim 10 was objected to because of a minor informality. Applicant corrected the informality by amendment, the objection is therefore withdrawn.

### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3622

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**10. Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**11.** Claims 1-4, 6-12 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Own Admissions in the specification (AOA) in view of Ruckart et al. (U.S. 6,950,506) in view of Holda-Fleck (U.S. 5,729,693).

**Claim 1:**

AOA, as shown, discloses the following limitations:

- *a free-call certificate management database for (see at least page 13, lines 7-8, databases are inherently used to store data on servers),*
- *storing information regarding sales of free-call certificates sold to one or more affiliated stores (see at least page 13, lines 7-8),*
- *said free-call certificate sale information containing sub-total free-call times allocated respectively to the affiliated stores within the range of a total free-call time allocated from at least one communication company (see at least page 13, lines 8-12),*
- *an authentication processor for (see at least page 15, line 13),*
- *searching the sale information stored in said free-call certificate management database for sale information corresponding to said affiliated store identification information to determine whether the corresponding sale*

*information is present in the stored sale information (see at least page 15, lines 13-19),*

- *performing an authentication process based on the determination result (see at least page 15, lines 19-20),*

AOA does not disclose the following limitations, however, Ruckart, as shown, does:

- *a free-call request information receiver (see at least column 6, line 53-55, central processor may communicate, transmit/receive, from phone network controllers and other computers see also lines 1-11 and 63-67),*
- *a free-call request information transmitter (see at least column 6, line 53-55, central processor may communicate, transmit/receive, from phone network controllers and other computers see also lines 1-11 and 63-67),*
- *receiving free-call request information containing a telephone number of a customer acquiring a specific one of the free-call certificates and affiliated store identification information from a specific one of one or more affiliated store terminals held respectively by said affiliated stores (see at least column 7, lines 3-7),*
- *transmitting said free-call request information authenticated by said authentication processor to a communication company server managed by said communication company so that the communication company server can deduct the amount of money corresponding to an individual free-call time allocated to said specific free-call certificate acquired by said customer from communication fees to be charged to said customer's telephone number contained in said free-call request information (see at least column 5, lines 20-22).*

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of

Art Unit: 3622

the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 2:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *a free-call time allocation information receiver* see at least page 13, lines 5-6),
- *receiving, from said communication company server, free-call time allocation information corresponding to said total free-call time contained in said free-call certificate purchase request information* (see at least page 13, lines 5-6),

AOA does not disclose the following limitations, however, Ruckart, as shown, does:

- *a free-call certificate purchase request information transmitter* for (see at least column 5, line 25-27),
- *transmitting free-call certificate purchase request information containing said total free-call time to said communication company server* (see at least column 5, lines 25-27).

Art Unit: 3622

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 3:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *a free-call certificate purchase request information receiver for* (see at least column 13, line 5-6),
- *receiving free-call certificate purchase request information containing each of said sub-total free-call times from each of said affiliated store terminals* (see at least column 13, line 9-10, in order to store this information, the system must somehow receive it),

AOA does not disclose the following limitations, however, Ruckart, as shown, does:

- *a free-call time allocation information transmitter for* (see at least column 5, line 25-27),

- *transmitting free-call time allocation information corresponding respectively to said sub-total free-call times contained in said free-call certificate purchase request information received by said free-call certificate purchase request information receiver respectively to said affiliated store terminals (see at least column 5, line 25-27),*

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 4:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *a settlement requestor for (see at least page 25, line 10-14, an online account transfer or credit card settlement are well known in the art),*
- *transmitting settlement request information to at least one financial company server to request it to settle said affiliated stores' accounts for prices for*



*purchases of said free-call certificates, respectively (see at least page 25, line 10-14, an online account transfer or credit card settlement are well known in the art),*

- *receiving results of settlement from said financial company server (see at least page 25, line 10-14, an online account transfer or credit card settlement are well known in the art).*

**Claim 6:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *said communication company server adapted for (see at least page 13, line 5-6, receiving from the communication company),*
- *allocating said total free-call time to said free-call certificate management server and (see at least page 13, line 5-6, receiving from the communication company),*

AOA does not specifically mention the functions of the communication company's server, however AOA admits receiving the data from the company, it is therefore inherent that the company have the capacity to send the data in the first place.

AOA does not disclose the following limitation, however, Ruckart, as shown, does:

- *in response to said free-call request information from said free-call certificate management server, deducting the amount of money corresponding to said individual free-call time allocated to said specific free-call certificate acquired by said customer from the communication fees to be charged to said customer's telephone number contained in said free-call request information (see at least Figure 3, reference 77),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers

Art Unit: 3622

via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 7:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Ruckart, as shown, discloses the following limitations:

- *said one or more affiliated store terminals, each adapted for (see at least column 7, lines 1-3),*
- *transmitting free-call request information containing a customer's telephone number and affiliated store identification information for authentication to said free-call certificate management server (see at least column 7, line 3-7),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 8:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Ruckart, as shown, discloses the following limitations:

- *said affiliated store terminals is further adapted to (see at least column 7, lines 1-3),*
- *transmit said free-call certificate purchase request information containing a corresponding one of said sub-total free-call times to said free-call certificate management server and (see at least column 7, line 3-7),*

Art Unit: 3622

- *receive said free-call time allocation information corresponding to the corresponding sub-total free-call time contained in said free-call certificate purchase request information from the free-call certificate management server (see at least column 7, line 3-7),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 23:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *said at least one financial company server adapted for (see at least page 25, line 10),*
- *processing the settlement associated with said free-call certificate purchase request information from each of said affiliated store terminals (see at least page 25, lines 3-5 and 10-14).*

**Claim 9:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *said at least one financial company server adapted for (see at least page 25, line 10),*
- *processing the settlement associated with said free-call certificate purchase request information from each of said affiliated store terminals (see at least page 25, lines 3-5 and 10-14).*

**Claim 10:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further Ruckart, as shown, discloses the following limitations:

- *at least one customer terminal for (see at least column 7, line 2, user terminal),*
- *receiving guide information about a free-call service from said free-call certificate management server and (see at least column 5, line 34-35),*
- *performing a telephone call using a free-call certificate issued to a corresponding customer (see at least figure 4),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 11:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further Ruckart, as shown, discloses the following limitations:

- *said customer terminal is a wireless communication terminal, said wireless communication terminal being any one of a mobile telephone or personal digital assistant (PDA) (see at least column 6, line 3-6),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

Art Unit: 3622

function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 12:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *said free-call certificate management server is adapted to transmit said guide information about said free-call service to said wireless communication terminal in the form of a short message service (SMS) message (see at least column 6, line 3-6),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 24:**

AOA, as shown, discloses the following limitations:

- *storing information regarding sales of free-call certificates sold to one or more affiliated stores a free-call certificate management database of the free-call certificate server (see at least page 13, lines 7-8),*
- *said free-call certificate sale information containing sub-total free-call times allocated respectively to the affiliated stores within the range of a total free-call time allocated from at least one communication company (see at least page 13, lines 8-12),*
- *searching the sale information stored in said free-call certificate management database for sale information corresponding to said affiliated store*

*identification information with an authentication processor of the free-call certificate management server to determine whether the corresponding sale information is present in the stored sale information (see at least page 15, lines 13-19),*

- *performing an authentication process based on a result of the searching the sale information stored in said free-call certificate management database for sale information corresponding to said affiliated store identification information (see at least page 15, lines 19-20),*

AOA does not disclose the following limitations, however, Ruckart, as shown, does:

- *(see at least column 6, line 53-55, central processor may communicate, transmit/receive, from phone network controllers and other computers see also lines 1-11 and 63-67),*
- *receiving free-call request information containing a telephone number of a customer acquiring a specific one of the free-call certificates and affiliated store identification information with a free-call request information receiver of the free-call certificate management server from a specific one of one or more affiliated store terminals held respectively by said affiliated stores (see at least column 7, lines 3-7),*
- *transmitting said free-call request information authenticated by said authentication processor to a communication company using a free-call request information transmitter of the free-call certificate management server (see at least column 5, lines 20-22),*
- *deducting an amount of money corresponding to an individual free-call time allocated to said specific free-call certificate acquired by said customer from communication fees to be charged to said customer's telephone number contained in said free-call request information using a communication company server*

Art Unit: 3622

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 25:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *receiving, from said communication company server, free-call time allocation information corresponding to said total free-call time contained in said free-call certificate purchase request information from a free-call time allocation information receiver of the free-call certificate management server of the free-call certificate management server (see at least page 13, lines 5-6),*

AOA does not disclose the following limitations, however, Ruckart, as shown, does:

- *transmitting free-call certificate purchase request information containing said total free-call time to said communication company server using a free-call*

*certificate purchase request information transmitter of the free-call certificate management server (see at least column 5, lines 25-27).*

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 26:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *receiving free-call certificate purchase request information containing each of said sub-total free-call times from each of said affiliated store terminals with a free-call certificate purchase request information receiver of the free-call certificate management server (see at least column 13, line 9-10, in order to store this information, the system must somehow receive it),*

AOA does not disclose the following limitations, however, Ruckart, as shown, does:



- *transmitting free-call time allocation information corresponding respectively to said sub-total free-call times contained in said free-call certificate purchase request information received by said free-call certificate purchase request information receiver respectively to said affiliated store terminals with a free-call time allocation information transmitter of the free-call certificate management server (see at least column 5, line 25-27),*

The system of Ruckart discloses a prepaid credit system where the customer purchases the calling credits from a store, and those credits are then applied to the customer account. It would have been obvious to one having ordinary skill in the art at the time of the invention to alter the Ruckart method by providing the prepaid calling credits to the customer free of charge as an award as taught by Holda-Fleck's rebate method and system where customers retrieve product rebates as telephone account credits and the telephone company bills the issuers of the rebates (manufacturers or stores) for the credit amounts periodically (see at least column 5, lines 19-31).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems and methods of Ruckart and Holda-Fleck with the techniques commonly known in the art (AOA) to enable a system to reward customers via their telephone accounts since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one having ordinary skill in the art would have recognized that the results of the combination were predictable.

12. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Own Admissions in the specification (AOA) in view of Ruckart et al. (U.S. 6,950,506) in view of Holda-Fleck (U.S. 5,729,693) and in view of **Official Notice**.

**Claim 5:**

The combination AOA/Ruckart/Holda-Fleck discloses the limitations as shown in the rejections above. Further AOA, as shown, discloses the following limitations:

- *said authentication processor searches the sale information stored in said free-call certificate management database for the sale information corresponding to said affiliated store identification information to determine whether the corresponding sale information is present in the stored sale information, and authenticates a specific one of said affiliated stores holding said specific affiliated store terminal as a result of the determination (see at least page 15, lines 12-15 and 17-20, see also page 16 lines 1-4),*

AOA does not disclose the following limitations, however Examiner takes **Official Notice** that processing refunds for purchases in the manner detailed in the limitations below is old and well known in the art.

- *a refund request information receiver for*
- *receiving refund request information containing a returned amount of a corresponding one of said sub-total free-call times and said affiliated store identification information from said specific affiliated store terminal; and*
- *a refund processor for*
- *requesting said financial company server through said settlement requestor to pay said specific affiliated store a refund corresponding to the returned free-call time amount contained in said refund request information received by said refund request information receiver, and*
- *updating said free-call certificate management database on the basis of said refund request information*

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to try to integrate a refund protocol with the techniques known in the art for authentication since there are a finite number of identified, predictable potential solutions (i.e. types of refund protocols) to the recognized need (refunding a purchase) and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

### Response to Arguments

13. Applicant's arguments filed 16 July 2008 have been fully considered but they are not persuasive. Each argument is addressed below:
14. Applicant argues "Applicants have not made any admission as to a database" (pp 12 of Applicant's Reply). Examiner disagrees for the following reasons. As examiner cited in the above rejections, Applicant admits the following: "[t]his integrated management process is well known to those skilled in the art" (see at least pp 13 of the specification, lines 12-13). Earlier in the same paragraph Applicant defines the admitted "integrated management process" to include "requesting the purchase of free-call certificates from one or more communication companies, receiving free-call times allocated respectively from the communication companies and storing information regarding the sales of free-call certificates sold to respective affiliated stores" (emphasis added) (see at least pp 13 of the specification, lines 3-7). Later in the specification Applicant admits the following: "[t]his technique for searching the database and performing the authentication process based on the search result is well known to those skilled in the art" (emphasis added) (see at least pp 16 of the specification, lines 1-3). Earlier in the same paragraph Applicant explains that the "authentication processor 130 searches the stored sale information... transmitted from the specific affiliated store terminal, received by the free-call request information receiver, to determine whether the corresponding sale information is present in the stored sale information" (emphasis added) (see at least pp15, lines 12-19). To summarize, Applicants admit (1) a process which includes storing information, then Applicants admit (2) a further process of searching the database containing the same information Applicant's admitted to storing. Therefore if it is old and well known in the art to store information, and later search the database for the same stored information, then the existence of the database containing the information and enabling the old and well known processes is inherent to Applicant's admission and is therefore itself old and well known in the art. Put another way how can a method for

Art Unit: 3622

searching a database be old and well known in the art if the database itself is not old and well known and is in fact new to the art?

15. Applicant argues “the free-call certificate management server 100 itself has not been admitted by Applicants” (pp 12 of Applicant’s Reply). This argument is moot. Examiner did not reject *the free-call management server* under Applicant admissions. Applicant further argues “nor is the free-call certificate management server 100 taught by Ruckart and/or Holda-fleck (or any combination thereof)” (pp 12 of Applicant’s Reply). This argument is moot. Examiner did not reject *the free-call management server* under Ruckart and/or Holda-fleck (or any combination thereof). The recitation *the free-call certificate management server* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
16. Applicant argues “the authentication processor 130 has not been admitted by the Applicants or taught by Ruckart and/or Holda-Fleck, but instead an operation thereof has been described” (pp 12 of Applicant’s Reply). Examiner disagrees for the following reasons. Applicant admits the following: “[t]his technique for searching the database and performing the authentication process based on the search result is well known to those skilled in the art” (emphasis added) (see at least pp 16 of the specification, liens 1-3). Earlier in the same paragraph Applicant explains that “[i]n the authentication process, the authentication processor 130 outputs...” (emphasis added) (see at least pp 15, lines 12-19). To summarize, Applicants admit (1) a specific process, then Applicants (2) define that process by disclosing the steps that “the authentication processor” takes. Therefore, according to Applicant’s specification the admitted process inherently includes an authentication processor that is capable of taking the disclosed steps. To be sure, one could argue that a method for hitting a baseball does not inherently require a baseball bat because other instruments could be employed in a given method; however the instrument specifically

disclosed in the given method is inherent to the given method and often serves to differentiate the method from another with similar objectives and results (i.e. hitting a base ball with a baseball bat versus hitting a base ball with a golf club). Here, Applicant's specifically state necessary structure for performing a specific method "*in the authentication process, the authentication processor 130 outputs*" so the authentication processor is inherent to the specific method. Then Applicant admits "*this technique for searching and performing the authentication process*" is well known in the art. Applicant does not suggest "a similar technique" or "comparable techniques," Applicant admits that "this" technique and performing "the" authentication process are old and well known, meaning that the specific methods described earlier in the paragraph are old and well known. Therefore the integral structural components disclosed in those specific methods are also deemed admitted prior art. Put another way how can a method for analyzing data using a specific processor be old and well known in the art if the processor that does the method itself is not old and well known and is in fact new to the art?

17. Applicants argue "Ruckart fails to teach or suggest a free-call request information receiver or a free-call request information transmitter" (pp 13 of Applicant's Reply). Applicant further contends that "the allegedly analogous free-call request information receiver and a free-call request information transmitter of Rukart is instead a mobile telephone switching office in communication with a computer system..." (*Id.*). However, Applicant does not point out the supposed error in applicant's interpretation of the broad limitations "information transmitter" and "information receiver." Although Applicant did not properly present an argument regarding these limitations, for the purposes of further clarifying Examiner's original rejection Examiner further expands and explains the rejection below. Section 2111 of the MPEP states the following:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard: The Patent and Trademark Office ("PTO") determines the scope of claims in patent

Art Unit: 3622

applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004).

In the specification several paragraphs disclose the nature of the *free-call information request receiver* (see at least pp 13, line 23; pp 27, line 13; pp 31, line 3, pp 49, line 7 and pp52, line 19) and the *free-call information request transmitter* (see at least pp 16, line 5; pp 28, line 2; pp 31, line 15; pp 38, line 19; pp 39, line 3, pp 49, line 21 and pp 53, line 8). In each paragraph Applicant describes the *receiver* only by detailing the information it receives and describes the *transmitter* only by disclosing that it transmits “communication information.” In light of the broad claim limitations and the limited guidance offered by the specification, Examiner rejected the claims as cited above by broadly interpreting the claims to include any apparatus that is capable of receiving the information and transmitting the information as Applicant described. The Ruckart invention teaches a system that receives information about call time to credit to customers from “for example a retail establishment” (see at least Ruckart column 5, lines 15-30) and transmits the same. The receiver/transmitter of Ruckart teaches the limitations in Applicant’s claims as cited above. Examiner encourages Applicant to read the entire Ruckart reference as some portions are better understood in the greater context of the Ruckart invention which may be explained in paragraphs that precede a particular column and line reference. Applicant only posits that the cited structure in the Ruckart invention is somehow different from the limitations in Applicant’s claims, but Applicant does not explain how or why. More importantly Applicant does not refer Examiner to a passage in the specification or in the claims that demonstrates the alleged differences between the cited art and the claimed limitations.

18. Applicant argues “[1] Holda-Fleck is silent, however, as to any physical elements of claim 1, as well as to subtracting an amount corresponding to a free-call time of a free-call certification with the free-call request information transmitter, i.e. automatically without any action by the consumer [and] [2] [f]urther Applicant’s respectfully disagree with Examiner’s characterization of the term

'rebate' as used in Holda-Fleck..." (pp 14 of Applicant's Reply). Applicant's first argument is moot because Examiner did not rely on the Holda-Fleck reference to teach any physical elements of claim 1. Further it is noted that some of the features upon which applicant relies (i.e., subtracting an amount corresponding to a free-call time of a free-call certification with the free-call request information transmitter, i.e. automatically without any action by the consumer) are not recited in the rejected claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Regarding Applicant's second argument, Applicant's "disagreement" is noted, but is not persuasive. As stated in the rejection, Holda-Fleck was only relied upon to teach that the calling minutes could be given to the intended recipients free of charge in the form of a rebate or reward. Again Examiner interpreted the limitation *free-call certificate* broadly in light of the specification. Examiner directs Applicant to page 3 lines 11-18 of the specification which states:

"it is an object of the present invention to provide a free-call certificate service system for returning a portion of the price for an online/offline product purchase or fee for online/offline service use to a customer in the form of a free-call certificate which allows the customer to conduct a telephone conversation free of charge up to a predetermined amount of money or for a predetermined period of time..."

Examiner maintains that the rebate to a "purchaser" in the form of calling time/money disclosed in Holda-Fleck that is credited to the "purchaser's telephone account" is analogous to the free-calling certificate of the invention, especially in combination with the previously cited references and especially when the "free-calling certificate" is broadly interpreted in light of the specification.

19. In Applicant's final argument Applicant's attempted to traverse Examiner's **Official Notice** taken in claim 5 (see pp 15 of Applicant's Reply). To adequately traverse such a finding, an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence

Art Unit: 3622

of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the Examiner’s assertion of official notice would be inadequate. See MPEP 2144.03(C). Here Applicant did not point out the supposed errors in Examiner’s assertions nor state why the limitations cited as old and well known are in fact not old and well known. Rather Applicant underlined a passage from the MPEP stating that “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” This passage does not apply to the limitations of claim 5 which Examiner contends are old and well known in the art because the limitations in question disclose only a refund request receiver, receiving a refund request, a refund processor, processing the refund and updating the databases of relevant parties to the refund. No esoteric technology is disclosed in the claims nor is any specific knowledge required to recognize that the claims are directed to old and well known art. Examiner maintains that the shopping public generally understands that refunds may be electronically processed in the manner described in claim 5. Examiner notes that claim 5 is a dependent claim and some limitations in claim 5 are repeated limitations or have antecedent basis from claims that were previously taught by the cited prior art in earlier rejections; notably the limitations drawn specifically to free-call certificate processing. Because Applicant’s traverse was inadequate, the common knowledge or well-known in the art statements are taken to be admitted prior art.



### **Conclusion**

- 20.** Having addressed each of Applicant's arguments, Examiner maintains the previous rejections for each claim, accordingly **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 21.** A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3622

22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
24. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

25. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
15 October 2008

/Arthur Duran/  
Primary Examiner, Art Unit 3622